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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885

7590 05/28/2003

Julie Blackburn
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625 Madison Avenue
New York, NY 10022

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/28/2003 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,000

Applicant(s)

PAGANO ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Receipt of Request for Continued Examination received on February 20, 2003 is acknowledged. Claims 1-19 and 21-27 are included in prosecution of this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-10, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Perronin et al (3,991,007).

Perronin discloses the preparation of pigmentary particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 11 provides a composition with 100 parts a pigment, 350 parts heptane, 27 parts methyl methacrylate, and 12 parts acrylic acid.

*Note that the preamble "nail enamel composition" does not hold patentable weight without reciting a structural limitation.

Claims 1-19 and 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated Pagano et al (5772988).

Pagano et al disclose a nail composition containing butyl acetate, a copolymer with a polar monomer (acrylic acid) and a nonpolar ethylenically unsaturated monomer, pigments, a suspending agent (stearalkonium bentonite), silicone glycol copolymer, and

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a plasticizer (glyceryl tribenzoate) in instant amounts (Note examples). Monomer A (ethylenically unsaturated monomer) is in the amount of 30-95%, monomer B (acetoacetoxymoiety) in the amount of 5-50%, and monomer C (acrylic acid) in the amount of 1-20%. Note column 5, lines 24-29. Monomer B is contained in 20% in the examples. Further, Pagano teaches an aqueous nail enamel composition (Note example 8). The composition can be in a kit (Note example 1) with a cellulose polymer. The nail enamel was tested and has instant nail residual effect (Note example 3).

*Note that since the applicant has not defined "substantially free" in the specification, it is the examiner's position that less than 50% reads on "substantially free."

Response to Amendment

The declaration under 37 CFR 1.132 filed July 15, 2002 is insufficient to overcome the rejection of claims 1-19 and 21-27 based upon being anticipated by US patent 5,772,988 as set forth in the last Office action because: a declaration cannot overcome an anticipatory reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagano et al (5772988).

Pagano et al disclose a nail composition containing butyl acetate, a copolymer with a polar monomer (acrylic acid) and a nonpolar ethylenically unsaturated monomer, pigments, a suspending agent (stearalkonium bentonite), silicone glycol copolymer, and a plasticizer (glyceryl tribenzoate) in instant amounts (Note examples). Monomer A (ethylenically unsaturated monomer) is in the amount of 30-95%, monomer B (acetoacetoxy moieties) in the amount of 5-50%, and monomer C (acrylic acid) in the amount of 1-20%. Note column 5, lines 24-29. Further, Pagano teaches an aqueous nail enamel composition (Note example 8). The composition can be in a kit (Note example 1) with a cellulose polymer. The nail enamel was tested and has instant nail residual effect (Note example 3).

Although Pagano teaches the range of monomer B to be from 5-50% and exemplifies 20%, he does not exemplify the minimum end of the range.

Assuming that applicant can provide support that "substantially free" is less than the exemplified 20%, it is deemed obvious to one of ordinary skill in the art at the time

the invention was made to manipulate the parameters of Pagano et al and include monomer B in the lower weight percent, i.e. 5%. One would be motivated to do so with the expectation of similar results since Pagano provides general guidance in making the copolymer and the suitable weight percent of the monomers contained in the copolymer.

As discussed above, it is the examiner's position that the lower range of the weight percent of monomer B reads on "substantially free" since applicant has not provided the parameters of substantially free and since Pagano's copolymer contains monomer A (instant monomer) in a greater quantity (30-95%).

Response to Arguments

Applicant states that the claims are amended to clarify that the polymer used in the composition does not contain any monomers that have acetoacetoxy moieties. It is argued that Pagano teaches a terpolymer with at least three monomers A, B, and C, wherein C is critical to the composition. Applicant argues that the Rule 132 declaration submitted that shows the unexpected non-yellowing characteristic of the instant invention, which is *free* of monomer B.

Applicant's arguments have been fully considered but they are not persuasive. The examiner points out that the claims recite "substantially free" and not "free of" as argued by applicant. As discussed in the rejection set forth above, Pagano teaches a lower limit wherein monomer B can be contained in the amount of 5% and the examples contain 20%, therefore the Pagano reads on substantially free since monomer B is not

the predominant monomer in the copolymer and the applicant has not defined substantially free.

In regards to the declaration, the examiner points out that the unexpected results are not commensurate in scope with the claims since the claims recite "substantially free" of monomer B. However, applicant provides unexpected results utilizing a composition completely free of monomer B. Furthermore, as discussed in the Office Action, Paper No. 6, applicant bases patentability on the use of two specific types of monomers and the subsequent polymerization to produce a polymer composition with the non-yellowing ability as discussed in Rule 132 Declaration. This non-yellowing property is not recited in the instant claims. As recognized by the applicant, Pagano teaches a polymer composition containing at least two different monomers and instant claims require two different monomers. Further, Pagano teaches the monomers of instant structure. Therefore, Pagano reads on instant claims since instant claim language does not exclude other monomers in the composition. Lastly, applicant uses the term "well-wear" which is also recognized by Pagano in general terms on column 9, lines 29-34.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for


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the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SSG


May 22, 2003


MICHAEL G. HARTLEY
PRIMARY EXAMINER